

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

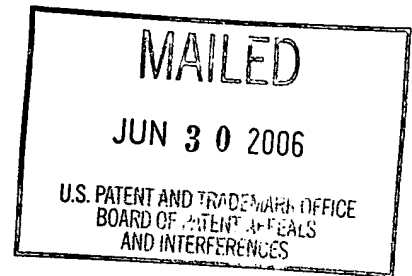
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN Y. F. PANG

Appeal No. 2006-1410
Application No. 09/353,537

ON BRIEF



Before JERRY SMITH, RUGGIERO, and MacDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims pending in this application.

The disclosed invention pertains to a system for policing unsolicited email (SPAM). Specifically, the system includes a policing server coupled to each client using a wide area network of computers such as the Internet. The policing server can receive an indication of an unsolicited email communication from at

least one client and proactively respond to such unwanted email. Such actions include performing various enforcement or policing actions to reduce the incidence of unwanted emails that can include, among other things, referring the sender to government authorities or notifying the sender's internet service provider to terminate the sender's account.

Representative claim 1 is reproduced as follows:

1. A system for policing an unsolicited e-mail communication comprising:

a plurality of clients, each coupled together using a wide area network of computers, the wide area network of computers comprising an Internet, each of the clients being adapted to send an indication of an unsolicited e-mail message through an e-mail device for a display;

a policing server coupled to each of the plurality of clients through the wide area network of computers, the policing server being adapted to receive the indication from at least one of the clients;

wherein the e-mail device comprises an [sic] SPAM icon on the display, the SPAM icon being adapted to send the indication from the client to the policing server.

The examiner relies on the following references:

McCormick 6,023,723 Feb. 8, 2000

Gianni, John, Here is a Zmail Ban-Spam Button, Comp.mail.zmail newsgroup, Oct. 7, 1997.

Macavinta, Courtney, FTC Searches for Spam Solution, CNET News.com, Jun. 12, 1997, available at <http://news.com.com/2100-1023-200486.html> (last visited Jan. 15, 2004).

The following rejections are on appeal before us:

1. Claims 1-10 and 13-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCormick in view of Gianni.

2. Claims 11, 12, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCormick in view of Gianni and Macavinta.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

We consider first the examiner's rejection of claims 1-10 and 13-19 based on the teachings of McCormick and Gianni. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5

USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370,

55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Regarding independent claims 1 and 13, the examiner's rejection essentially finds that McCormick teaches every claimed feature except for a SPAM icon on the display that is adapted to send an indication of an unsolicited email message from the client to the policing server [answer, pages 4 and 10]. The examiner cites Gianni as teaching providing a SPAM icon on the user's display that enables the user to ban repeated instances of unsolicited junk email via a push-button interface [answer, pages 4 and 10]. The examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify McCormick's system to provide a SPAM icon on the display to assist the user in removing SPAM faster [answer, pages 4 and 5].

Appellant argues that the cited prior art does not disclose a policing server as claimed [brief, page 7]. Appellant contends that the term "policing server" has a special meaning—i.e., a policing server "performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers" [brief, page 7, emphasis added]. According to appellant, policing servers proactively respond to unwanted email with actions such as contacting the spammer's internet service provider (ISP), contacting government authorities, submitting the spammer's ISP to a "black list," initiating private legal action, etc. Appellant argues that policing servers are distinguished from passive servers that merely filter incoming email since such passive filtering servers do nothing to actually stop the spammer from sending the SPAM in the first place [brief, pages 4, 5, and 7].

The examiner responds that McCormick's address filter server 22 is a policing server that performs actions including, among other things, periodically updating email filter addresses in conjunction with database server 24 [answer, pages 9 and 10]. Appellant argues that McCormick's address filter server 22 merely receives and redistributes email filters and is not a "policing server" as claimed [brief, page 7].

We will sustain the examiner's rejection. We agree with the examiner that McCormick's address filter server 22 reasonably reads on a "policing server" as claimed given the limitation's broadest reasonable interpretation.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). But the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). See also MPEP § 2111. Thus, claim terms must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). See also MPEP § 2111.01(I). The "plain meaning" of a claim term refers to its ordinary and customary meaning -- the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. See Phillips v. AWH Corp., 415 F.3d 1303, 1312-13, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc). "The person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification" [id.]. See also MPEP § 2111.01(II).

McCormick's address filter server 22 periodically and automatically receives addresses of unknown email that is stopped by the user's automatic discard filter 12. Furthermore, delta server filter 26 from all other users is

coupled to the address filter server to maintain and update the current filter list.

The address filter server operates in conjunction with database server 24 to download updated filter addresses to various users in the system [see McCormick, Fig. 1; col. 4, lines 43-62; col. 3, lines 53-59].

McCormick's server-based filter updating system reasonably reads on a "policing server" as claimed given the term "policing" its broadest reasonable interpretation. Initially, we note that the plain meaning of "policing" is broader than appellant's definition on page 7 of the brief. As noted above, we must give the term "policing" its plain meaning absent a clear definition in the specification. Zletz, 893 F.2d at 321, 13 USPQ2d at 1322. According to Webster's New World Dictionary, 3d College ed., the term "policing" is defined as follows:

1. to control, protect, or keep orderly with or as police or a similar force...
2. to make or keep...clean and orderly...

Webster's New World Dictionary, 3d College ed., 1988.

Periodically updating email filters via a server to render the users' filters more robust as in McCormick is an action that ultimately reduces the incidence of unwanted email messages at the user's inbox. In our view, the server's role in updating the users' filters reasonably constitutes "policing" given the term its broadest reasonable interpretation. Furthermore, even with appellant's definition of "policing server" on page 7 of the brief, we note that filtering unwanted email via a server is an action that would, at least at the user's inbox, reduce the incidence of further identical SPAM email messages sent from the same

spammer. The examiner's construction of "policing server" to include the system of McCormick is therefore reasonable.

We also agree with the examiner that McCormick reasonably teaches coupling the "policing server" to each of the plurality of clients through a wide area network as claimed. As noted above, McCormick's delta server filter 26 is associated with all other users and is coupled to the address filter server 22 to maintain and update the current filter list. Moreover, McCormick's address filter server is linked to clients' PCs via the internet and/or an intranet 11 [see McCormick, Fig. 3].

Regarding the combination of Gianni with McCormick, we find that the examiner has established at least a prima facie case of obviousness that appellant has not persuasively rebutted. We agree with the examiner that Gianni fairly teaches providing a SPAM icon on the user's display that is reasonably combinable with the system of McCormick particularly since the user in McCormick communicates with the address filter server 22 to update the filter list. A SPAM icon on the user's display would provide an intuitive way for the user to quickly and easily report newly-received SPAM addresses to the address filter server in McCormick for future filter updates.

We will also sustain the examiner's rejection of dependent claims 3, 4, 6-10, 15, 16, 18, and 19. The examiner has (1) pointed out the teachings of McCormick and Gianni, (2) pointed out the perceived differences between McCormick and the claimed invention, and (3) reasonably indicated how and why

McCormick would have been modified in light of the teachings of Gianni to arrive at the claimed invention. Once the examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to appellant to present evidence or arguments that persuasively rebut the examiner's prima facie case. Appellant did not persuasively rebut the examiner's prima facie case of obviousness. The rejection of dependent claims 3, 4, 6-10, 15, 16, 18, and 19 is therefore sustained.

We now consider the examiner's rejection of claims 2 and 14 based on the teachings of McCormick and Gianni. As an initial matter, we disagree with appellant's contention that "claims 2 and 14 recite reporting an unauthorized e-mail message to the 'policing server'" [brief, page 8; emphasis added]. Claims 2 and 14, however, merely recite that "the policing server is adapted to report the unauthorized e-mail message." Nevertheless, appellant argues that "the policing server is not the same as the spammer's server" [brief, page 8]. The examiner responds that the reporting limitation is met since Gianni's system automatically sends the spammer a "permission denied" message [answer, pages 5, 10, and 11].

We agree with the examiner that Gianni reasonably teaches reporting receipt of an unauthorized email message after the spammer is added to the "banned" file. Such a teaching, in our view, is reasonably combinable with McCormick. In addition, the scope and breadth of the claims merely calling for the policing server to "report" the unauthorized email message does not preclude

the functionality of McCormick's address filter server that "reports" new filter addresses to database server 24. The examiner's rejection of claims 2 and 14 is therefore sustained.

Regarding claims 5 and 17, appellant argues that McCormick does not teach or suggest that the policing server maintains a log of unsolicited email communication as claimed. According to appellant, McCormick only shows that addresses are included on the current filter list with the address filter server stored in the filter database [brief, page 8]. The examiner responds that both McCormick and Gianni teach the claimed logging feature. According to the examiner, (1) McCormick's "No Admittance List" 52 constitutes a log of unsolicited email, and (2) Gianni creates a log file whenever a spammer is added to the "banned" file [answer, pages 11 and 12].

We will sustain the examiner's rejection of claims 5 and 17. We agree with the examiner that the cited prior art reasonably suggests logging unsolicited email communication given the scope and breadth of the limitation. Moreover, we see no reason why such a teaching would not be applicable to the address filter server in McCormick particularly since the user in McCormick communicates with the address filter server 22 to update the filter list. The examiner's rejection of claims 5 and 17 is therefore sustained.

We now consider the examiner's rejection of claims 11, 12, and 20 based on the teachings of McCormick, Gianni, and Macavinta. The examiner essentially finds that the prior art discloses all of the claimed features except for

providing the policing server at a governmental authority [answer, page 6]. The examiner then relies on Macavinta who discusses the authority of the Federal Trade Commission (FTC) to crack down on spammers as well as legislation that would give the FTC additional authority to punish spammers. The examiner concludes that, in view of Macavinta, it would have been obvious to the skilled artisan at the time of the invention to provide the policing server of the cited prior art at a governmental authority to stop spammers [answer, pages 7, 12, and 13].

Appellant responds that Macavinta merely describes the FTC's proposed power to force spammers to give an opt-out preference, but does not teach or suggest any mechanism (e.g., a policing server) for performing this action [brief, page 9]. Appellant also argues that the examiner provided no motivation to combine the references, and even if the references could be combined, all the limitations of claims 11, 12, and 20 are still not met [brief, page 9].

We will sustain the examiner's rejection of claims 11, 12, and 20. Macavinta discusses the U.S. government's interest in not only reducing SPAM, but also the FTC's enforcement role under its authority. Additionally, the article notes that the FTC's authority to punish spammers would increase under then-pending legislation. Thus, in view of the U.S. government's interest in reducing SPAM and involvement in enforcement as discussed in Macavinta, we conclude that the skilled artisan would have reasonably applied such a teaching to the McCormick/Ginnani system. As noted previously, the examiner's interpretation of "policing server" reasonably includes the address filter server 22 of McCormick

that is remote from the user. Because the McCormick/Gianni system is designed to reduce unwanted email, and in light of Macavinta's teachings of increased government involvement in enforcement to reduce unwanted email, we agree with the examiner that it would have been obvious to the skilled artisan at the time of the invention to locate the policing server of the cited prior art at a governmental enforcement authority such as the FTC. With such a system, not only would users be able to continue to filter unwanted email, but addresses of senders of unsolicited email could also be identified for possible enforcement actions. The examiner's rejection of claims 11, 12, and 20 is therefore sustained.

In summary, we have sustained the examiner's rejection with respect to all of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-20 is affirmed.


No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Jerry Smith
JERRY SMITH
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge

Administrative Patent Judge



ALLEN R. MacDonald
Administrative Patent Judge

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Appeal No. 2006-1410
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